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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/540,988   | 01/20/2006  | Frank Hofmann        | HOFMANN-5           | 9572             |
| 20151 7590 03/17/2009<br>HENRY M FEIEREISEN, LLC<br>HENRY M FEIEREISEN<br>708 THIRD AVENUE<br>SUITE 1501<br>NEW YORK, NY 10017 |             |                      |                     |                  |
| EXAMINER   |             |                      |                     |                  |
| SINGH, SUNIL   |             |                      |                     |                  |
| ART UNIT   |             | PAPER NUMBER         |                     |                  |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/540,988

**Applicant(s)**

HOFMANN, FRANK

**Examiner**

Sunil Singh

**Art Unit**

3672

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11, 16 and 17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 16 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 June 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the further sewer pipe and boring device must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-11 are rejected under 35 U.S.C. 101 because they improperly embrace both product and process. The language of 35 U.S.C 101 sets forth statutory classes of invention in alternative only. See *Ex parte Lyell*, 17 USPQ2d 1549.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-11 are ambiguously constructed and indeterminate in scope because they purport to claim both a product and method of using or practicing the product in a single claim.

For example, claim 1, "when the sewer pipe is drawn", appears to be a method step.

Claim 1 is confusing because it is unclear how the "sewer pipe" in line 1 is attached to an element which includes a further "sewer pipe".

Claims 7 and 8 are confusing because they call for "the element" which is either a further sewer pipe or boring device. Therefore, the sewer pipe called for in claim 1 line 1 cannot comprise "a sewer pipe".

Claim 16 is confusing because the "element" is either the second sewer pipe or the boring device; therefore it is not clear if the first sewer pipe is connected to the second sewer pipe or the boring device. The claim appears to require for the first sewer pipe to be connected to both; if that were the case it appears that essential elements are then missing.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1,3,4,6,7,8,9,10,11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hahn et al. '256 in view of Lee (US 4779902).

Hahn et al. discloses first and second sewer pipes (2), each including partial pipe shells (see Figs. 1-5, 7-8, 12-17), first connecting means connecting the partial pipe shells firmly to one another (see col. 3 lines 5-10, 55-65, col. 7 lines 55-65, see Figs. 1-5, 7-8, 12-17). Latch/recess (see Figs. 1-5, 7-8, 12-17, in particular Fig. 14). Seal between partial pipe shells (see col. 3 lines 5-10, 55-65, col. 7 lines 55-65). Plastic (see col. 7 lines 55-65). Hahn et al. discloses the invention substantially as claimed. However,

Hahn et al. is silent about including connecting means for transmitting a tensile force when the sewer pipes are attached longitudinally to one another and drawn horizontally into the ground by a device and a seal arranged between the first and second sewer pipes. Lee teaches connecting means (see Figs. 1,2) for transmitting a tensile force when the sewer pipes are attached longitudinally to one another and a seal (51) arranged between the first and second sewer pipes. It would have been considered obvious to one of ordinary skill in the art to modify Hahn et al. to include the "second" connecting means and seal as taught by Lee in order to reduce leakage between the first and second pipes.

With regards to claim 11, it would have been considered obvious to modify Hahn et al. by reinforcing the plastic pipe via glass fibers in order to provide a pipe that would not buckle easily.

8. Claims 2,3,5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hahn et al. in view of Lee as applied to claim 1 above, and further in view of either Knox et al. or Sullivan or Swisher or Ahn et al. or Petrovic or Fisher or Tyrer et al. (US 4286640, 4826215, 5531695, 6227251, 6311734, 6916051, 7100641 ) or Dennehey et al. (US 4340052).

Hahn et al. (once modified) discloses the invention substantially as claimed. However, the (once modified) Hahn et al. is silent about the pipe shells being connected via a hinge. Knox et al., Sullivan, Swisher, Ahn et al., Petrovic, Fisher, Tyrer et al. and Dennehey et al. all disclose a pipe comprising partial pipe shells being connected via a

hinge (see Figs. 1-2, 2, 4, 3, lc, 3, 2, 3-4). It would have been considered obvious to one of ordinary skill in the art to further modify the (once modified) Hahn et al. to include the hinge as taught by either Knox et al. or Sullivan or Swisher or Ahn et al. or Petrovic or Fisher or Tyrer et al. or Dennehey et al. in order to reduce time involved in attaching the partial pipe shells together.

9. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP document '583 in view of Lee and Hahn et al.

EP document '583 discloses a method for laying a sewer pipe (22,24) comprising the steps of connecting an end of a first sewer (24) to a boring device (21,22,20) and/or second sewer pipe and drawing the sewer pipe into the ground by means of the boring device (see Figs. 5, 6,7,10,11). EP document discloses the invention substantially as claimed. However, EP document lacks a connection means between the first sewer and the boring device and/or the second sewer pipe that enable a transmission of tensile forces and a seal between first and second sewer pipes. Further, EP document lack sewer pipe assembled from partial pipe shells. Lee teaches connecting means (see Figs. 1,2) between sewer pipes and/or a device for transmitting a tensile force when connected and a seal (51) arranged between the first and second sewer pipes. Hahn et al. teaches partial pipe shells (see Figs. 1-5, 7-8, 12-17). It would have been considered obvious to one of ordinary skill in the art to modify EP document to include the connecting means and seal as taught by Lee in order to reduce leakage between the connected sections. Further, it would have been considered obvious to one of

ordinary skill in the art to modify EP document to assemble the sewer pipe via partial pipe shells as taught by Hahn et al. in order to have to avoid interrupting the supply lines.

10. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP document in view of Lee and Hahn et al. as applied to claim 16 above, and further in view of either Knox et al. or Sullivan or Swisher or Ahn et al. or Petrovic or Fisher or Tyrer et al. (US 4286640, 4826215, 5531695, 6227251, 6311734, 6916051, 7100641 ) or Dennehey et al. (US 4340052).

EP document. (as modified above) discloses the invention substantially as claimed. However, the (as modified above) EP document is silent about the pipe being formed as partial pipe shells which are connected together via a hinge. Knox et al., Sullivan, Swisher, Ahn et al., Petrovic, Fisher, Tyrer et al. and Dennehey et al. all disclose a pipe comprising partial pipe shells being connected via a hinge (see Figs. 1-2, 2, 4, 3, 1c, 3, 2, 3-4). It would have been considered obvious to one of ordinary skill in the art to further modify the (as modified above) EP document to include the partial pipe shells which are connected together via a hinge taught by either Knox et al. or Sullivan or Swisher or Ahn et al. or Petrovic or Fisher or Tyrer et al. or Dennehey et al. in order to have to avoid interrupting the supply lines.



***Response to Arguments***

11. Applicant's arguments with respect to claims 1 and 16 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sunil Singh whose telephone number is (571) 272-7051. The examiner can normally be reached on Monday through Friday 10:30 AM - 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (571) 272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sunil Singh/  
Primary Examiner, Art Unit 3672

Sunil Singh  
Primary Examiner  
Art Unit 3672

SS 3/12/09

